

REMARKS / DISCUSSION OF ISSUES

Claims 1-7 and 21 are under present consideration. Claim 1 is independent.

Objection to the Drawings

The Office Action objects to the drawings for allegedly failing to show all features of the claims. In particular, there is allegedly confusion relative to the use of reference character 37 to designate both the leaf-type spring and the rod-type spring. Applicants note that the amendment to claim 3 renders this objection moot. However, the reference character 37 is drawn to spring means 37, which is described in the filed application:

As can be seen from FIG. 6, the spring means 37 is formed in the hair-cutting apparatus 1 by a rod-like spring 37 that extends substantially transversely to the direction of suction 31, that extends in a curve, that is fastened in place in the region of the lateral passage wall 28 and the free, curved end of which cooperates with a strip 38 projecting from the portion 35. The spring 37 may however also be leaf-like.

Thus, spring means 37 comprise leaf-like springs and rod-like springs.

Objection to the Specification

1. Applicants thank the Examiner for providing information about recommended section headings. Applicants again decline to add the section headings.
2. The Abstract was object to and has been amended to rectify certain issues. Notably, the Abstract of the filed application is that of the International Application and is provided via the cover page of the International Application. Thus, the placement of the corrected Abstract is presumed to be after the last page of the filed application. Based on the corrected Abstract submitted, Applicants believe that the objections are now moot.

Rejections under 35 U.S.C. § 112, ¶ 2

Claim 3 has been amended to delete the term 'type' and to delete 'rod-type', rendering this rejection moot.

Rejections under 35 U.S.C. § 102

1. Claims 1,2,5, 6 and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Severson* (U.S. Patent 1,506,139). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.
2. Claims 1-3 and 5-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Zucker* (U.S. Patent 3,302,286). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

At the outset, Applicants note that the rejections for anticipation set forth in the present Office Action, have been reviewed and appear to be substantially identical to those set forth in the Office Action of February, 2007. Applicants have responded to all such rejection in the previous response under Rule 111. Notably, the present rejections include a rejection of claim 21, which depends from claim 1. For reasons set forth herein, claim 21 is also allowable.

Applicants reproduce their response to the rejections of claims 1-3,5, 6 and 21 in view of *Severson* and *Zucker* in the interest of simplicity.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed.

Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

i. Rejection in view of Severson

Claim 1 is drawn to a hair-cutting apparatus and features:

“...[a] *movable portion being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition of the hair.***”

In an embodiment, when the movable/adjustable portion 35 of the passage wall 22 is cooperating with hair to be cut, the adjustable portion 35 is adjustable in opposition to the force exerted by the spring means 37, i.e. in the direction of suction 31, as indicated in FIG. 7. The amount by which the adjustable portion 35 is adjusted is dependent in this case on the nature and condition of the hair, i.e. **on the density of the hair, the length of the hair, the thickness of the hair and the stiffness of the hair.**

The Office Action asserts¹:

that is movable relative to the stationary portion. Severson also teaches that the movable portion is being arranged and positioned to cooperate with the hair to be cut dependent on the nature and condition of the hair. It should be noted that the movable portion 37 moves back on its pivot against the action of spring 41 when the movable portion is pushed against the hair. Therefore, the movement of the movable portion is according to the nature and condition of the hair. See Figs. 1-3 and page 2, lines 6-115 in Severson.

¹ Applicants note that the portion of the Office Action reproduced is from the February, 2007 Office Action. Notably, however, the present Office Action includes this Response to Applicants' Arguments in verbatim. Thus, Applicants traverse the rejection based on their earlier position.

At the outset, the undersigned believes that the reference characters noted above do not properly refer to the applied art, but rather to an amalgamation of the reference characters of the applied art and the features of claim 1. For instance, '37' refers to a hood or shield in the reference; and '41' refers to the medial coil of the spring 41. Regardless, the hood or cover 37 is used to regulate suction.

Moreover, while the reference discloses the pivoting of the instrument at portion 11 to regulate the length of the hair, there is no disclosure of the *movable portion's being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition** of the hair*. To wit, only the length of the hair is of concern; and the regulation of the length is by a pivot point at portion 11, which is not even a moveable portion, let alone one arranged and positioned to cooperate with the hair to be cut dependent on the nature and condition of the hair. Stated differently, the hood or cover 37 and its spring actuation 40 are provided to regulate suction, and are not arranged to cooperate with the hair to be cut dependent on the nature and condition of the hair as claimed. Moreover, the reference does not disclose the adjustability of the hair-cutting apparatus dependent on the nature and condition of the hair as claimed.

ii. Rejection in view of Zucker

The Office Action asserts that the comb plate 59 of *Zucker* anticipates the *movable portion's being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition** of the hair* as featured in claim 1. Applicants respectfully disagree.

The comb plate 59 is floatingly mounted to the main frame 12 by wings or extensions 62. The comb plate 59 includes teeth 60 and lifts hair and aligns it and brings it into cutting position in juxtaposition with the clippers 24a. However, the reference fails to disclose the arrangement of a movable portion *being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition***. Rather, there is merely a description of aligning the hair to be cut; and conspicuously there is neither

mention of nature or condition of the hair being cut nor of the adaptability of the position and arrangement of any components dependent thereon.

iii. Rejections are Improper

1. For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of independent claim 1. Thus, a *prima facie* case of anticipation has not been made and claim 1 is patentable over the applied art. Moreover, claims 2-7 and 21, which depend from claim 1 are patentable for at least the same reasons.

2. Applicants have noted that the rejections for anticipation are substantially the same in substance to those set forth in the Office Action of February 2007, which drew Applicants traversal. Thus, Applicants' position set forth herein is substantively the same as that of the last response under Rule 111. Applicants respectfully submit that the present Office Action is not compliant with the basic tenets of MPEP § 706. To this end, Applicants note that this section of the MPEP states, inter alia:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection, before issuing the next Office action. (Emphasis provided.)

Respectfully, Applicants provided arguments and evidence responsive to the rejection of claims 1-3, 5, 6 in the Response of May 21, 2007. The present Office Action merely reiterates the rejections of February, 2007. In furtherance to this point, not only is the Response to Applicants Arguments identical to those of the February, 2007 Office Action, but also, there is no consideration paid therein to Applicants' traversal of the rejections based on *Zucker*. For at least these reasons, Applicants respectfully submit that the present rejections for anticipation are improper for failing to comply with MPEP § 706

Rejections under 35 U.S.C. § 103

The rejection of claims 3 and 4 under this section of the Code has been considered. As these claims depend from claim 1, which is patentable over the applied art, claims 3 and 4 are patentable for at least the same reasons.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

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